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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,631	02/15/2001	Jose A. Fernandez-Pol	42108.0106	2674

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THOMPSON COBURN, LLP.
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

COPPINS, JANET L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,631

Applicant(s)

FERNANDEZ-POL, JOSE A.

Examiner

Janet Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-53 and 65-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-53 and 65-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s): _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Claims 13-83 pending in the instant application.

Response to Amendment

1. Receipt is acknowledged of Applicant's Amendment C, submitted 4/21/03, which papers have been reviewed by the Examiner and entered of record in the file as Paper No. 17.

Accordingly, claims 54-64 have been cancelled, claims 13, 18, 21, 39, 43, 47, 48, 53, 65, 69, 70, 74, 75, 78, 79, 81, and 83 have been amended, and new claims 84-111 have been added.

Inventorship

2. In view of the papers filed 9/19/02, it has been found that this nonprovisional application, as filed, improperly set forth the inventorship, since the only named inventor, Jose A. Fernandez-Pol, has disclaimed his involvement with the invention. The inventor certifies that he has not participated sufficiently in the conception and design of the work of the instant application, and did not approve of its submission (see Paper No. 19). Therefore the inventorship of this application has been assigned to the Assignee, under 37 C.F.R. 1.47(b).

Response to Arguments

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. (a) Claims 13, 18, 21, 39, 43, 47, 48, 53, 54, 58, 59, 63, 69, 70, 74, 75, 78, 79, and 83 previously rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, and as containing subject matter which was not sufficiently described in the specification. The Applicant claims "A peptide of sixteen amino acids," which is critical or essential to the practice of the invention, but said amino acids are not included in the claims and are not enabled or described by the disclosure. Applicants have removed the phrase "A peptide of sixteen amino acids" from said claims, obviating the enablement rejection. Therefore the Examiner withdraws the 35 USC 112, first paragraph rejections of said claims.

(b) Claims 79, 81, and 83 employ the term "contacting" in line 1, rendering the claims indefinite, as it is unclear if the two ingredients are physically contacted with each other or if they are reacted together thus causing a chemical reaction. Applicants have clarified the term "contacting," therefore the Examiner withdraws the 35 USC 112, second paragraph rejections of said claims.

(c) Claim 81 previously rejected under 35 USC 112, second paragraph, for reading on 0%, and therefore being vague and indefinite. Applicant has amended claim 81 to include "comprising" language, which still reads on 0%, and is still vague and indefinite. Thus the claim is still unclear and the Examiner maintains the 35 USC 112, second paragraph rejection.

(d) Claims 13, 18, 21, 39, 43, 47, 48, 53, 54, 58, 59, 63, 69, 70, 74, 75, 78, 79, and 83 recite the phrase "a peptide of sixteen amino acids..." which render the claims indefinite. The "sixteen amino acids" which could be ascertained and combined to form the peptide are not listed or defined by the claims. The Applicant had amended said claims to remove the rejected

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terminology from the claims, therefore the Examiner withdraws the 35 USC 112, second paragraph rejections of said claims.

(e) Claim 109 recites the phrase, "A composition comprising interferon and a compound ..." which is vague and indefinite. Interferons are any of a group of glycoproteins produced by cells in response to infection by a virus, that act to prevent viral replication and have the ability to induce resistance to viral antigens. Therefore it is unclear which interferon the Applicants are intending to claim. For example, on page 14 of the specification, Applicants discuss interferon-gamma, however the claim fails to specify which interferon is included in the composition.

(f) Claims 110 and 111 are rejected under 35 U.S.C. 112, second paragraph, as being dependent on a rejected indefinite base claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13-22, 24, 28-30, 32-34, 38-40, 43-74, in part, previously rejected under 35 U.S.C. 102(b) as being anticipated by Otsu et al., US No. 5,582,817. The Applicant has traversed the rejection. In view of Applicant's persuasive arguments and cancellation of claims 58-64, the Examiner withdraws the 35 USC 102(b) rejections of the claims.

8. However, Applicant's arguments are moot in view of the new ground(s) of rejection:

----- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: -----

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A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

9. Claims 13-53 and 65-111 rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. In view of paragraph 2 above, the current only named inventor has refused to execute the instant application, and has removed himself as an inventor of the claimed invention, please refer to the letter submitted by Jose A. Fernandez-Pol, Paper No. 19. Fernandez-Pol states that although he is the sole inventor named, he refuses to take responsibility for the work, and that he cannot warrant that the application represents valid original work.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Coppins whose telephone number is 703.308.4422. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703.308.4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703.746.9037 for regular communications and 703.872.9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1235.

Janet L. Coppins
July 28, 2003


CEILA CHANG, Acting SPE
PRIMARY EXAMINER
GROUP 1200